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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/848,818	05/19/2004	David A. Kitch	7178	4774
55740	7590	09/01/2006	EXAMINER	
GAUTHIER & CONNORS, LLP			NORDMEYER, PATRICIA L	
225 FRANKLIN STREET			ART UNIT	
BOSTON, MA 02110			PAPER NUMBER	

1772

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/848,818

Applicant(s)

KITCH ET AL.

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Withdrawn Rejections

1. The 35 U.S.C. 102(b) rejection of claims 1 – 5 and 8 – 17 as anticipated by Begelfer et al. in the office action dated March 7, 2006 is withdrawn due to Applicant's amendment in the response dated June 30, 2006.

2. The 35 U.S.C. 102(b) rejection of claims 1 – 19 as anticipated by Smith in the office action dated March 7, 2006 is withdrawn due to Applicant's amendment in the response dated June 30, 2006.

3. The 35 U.S.C. 102(b) rejection of claims 1 and 20 as anticipated by EP 0 681 913 A1 in the office action dated March 7, 2006 is withdrawn due to Applicant's amendment in the response dated June 30, 2006.

Response to Amendment

4. The declarations under 37 CFR 1.132 filed June 30, 2006 are insufficient to overcome the rejection of claims 1 – 5 and 8 - 17 based upon Begelfer et al. and claims 1 – 19 based upon Smith as set forth in the last Office action because: While the declarations states the properties listed in claims 3 – 5 and 8 – 16 are critical properties to the invention, there is no evidence that supports either sides of the properties in question. Therefore, the declarations are have been considered but are not deemed persuasive.

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5. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 – 5, 8 – 11 and 13 – 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Begelfer et al. (USPN 4,915,994).

Begelfer et al. disclose a multilayer composite comprising a face stock of polyvinyl chloride having bottom and top surfaces (Column 2, lines 66 – 67), at least the bottom surface of said face stock being printable (Column 5, lines 20 – 22 – wherein the since the top layer contains printing, the bottom surface of the face stock would also be printable) and a carrier sheet laminated directly to the top surface of said face stock at an interface there between (Column 4, lines 30 – 36) as in claims 1 and 2. With regard to claims 1, 3 – 5, 8 – 11 and 13 – 16, it is inherent that the multilayer composite distorts more than 1.0% in either the machine or cross machine direction when in an unrestrained state and exposed to temperatures above about 140°F and when subjected to tension greater than about 0.5 PLI, has a low flexural stiffness, has elongation characteristics as measured in accordance with ASTM D 8-22 greater than 50% in at

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least one direction, has elongation characteristics greater than 100% in at least one direction, has a stiffness greater than about 60 grams, the bond strength at said interface is less than the respective tensile strengths of said face stock and said carrier sheet and the yield strength of the said face stock, the bond strength as measured in accordance with FTM3 is less than 60, 100 or 200 grams per 2 inch width and the stiffness and tensile strength of the carrier sheet prevents distortion since Begelfer et al. discloses the same material as claimed (Column 2, lines 66 – 67; Column 4, lines 30 – 36) and given the stability of the material used in the construction of the composite (Column 4, lines 44 – 68). A liner is releasably adhered by means of a pressure sensitive adhesive to the bottom surface of the face stock material (Column 4, lines 36 – 41) as in claim 17.

8. Claims 1 – 11 and 13 – 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith (USPN 6,086,995).

Smith discloses a multilayer composite comprising a face stock of polyvinyl chloride having bottom and top surfaces (Column 16, lines 42 – 45), at least the bottom surface of said face stock being printed with graphics between the face stock and adhesive (Column 8, lines 9 – 15) and a carrier sheet laminated directly to the top surface of said face stock at an interface there between (Column 8, lines 32 – 35) as in claims 1, 2, 18 and 19. The face stock has a thickness between 0.25 to 3.5 mils and 1 and 3 mils (Column 8, lines 53 – 62) as in claims 6 and 7. With regard to claims 1, 3 – 5, 8 – 11 and 13 – 16, it is inherent that the multilayer composite distorts more than 1.0% in either the machine or cross machine direction when in an unrestrained state

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and exposed to temperatures above about 140°F and when subjected to tension greater than about 0.5 PLI, has a low flexural stiffness, has elongation characteristics as measured in accordance with ASTM D 8-22 greater than 50% in at least one direction, has elongation characteristics greater than 100% in at least one direction, has a stiffness greater than about 60 grams, the bond strength at said interface is less than the respective tensile strengths of said face stock and said carrier sheet and the yield strength of the said face stock, the bond strength as measured in accordance with FTM3 is less than 60, 100 or 200 grams per 2 inch width and the stiffness and tensile strength of the carrier sheet prevents distortion since Smith discloses the same material as claimed (Column 16, lines 42 – 45; Column 8, lines 32 – 35) and the desired thickness of the materials (Column 8, lines 53 – 62). A liner is releasably adhered by means of a pressure sensitive adhesive to the bottom surface of the face stock material (Column 16, lines 57 – 60) as in claim 17.

9. Claims 1, 3 – 11 and 13 – 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Dollinger (USPN 5,151,309).

Dollinger discloses a multilayer composite comprising a dimensionally unstable face stock (Column 2, lines 44 – 55) having bottom and top surfaces (Figure 4, #12), at least the bottom surface of said face stock being printed with graphics between the face stock and adhesive (Column 4, lines 47 – 50, wherein the since the top layer contains printing, the bottom surface of the face stock would also be printable) and a carrier sheet laminated directly to the top surface of said face stock at an interface there between (Figure 4, #14; Column 4, lines 59 – 61;

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Column 5, lines 14 – 15) and removable from the top surface of said face stock due to the adhesive layer (Column 5, lines 14 – 15) as in claims 1, 18, 19 and 22. The face stock has a thickness between 3 mils and 4 mils (Column 6, lines 66 – 67) as in claims 6 and 7. With regard to claims 1, 3 – 5, 8 – 11, 13 – 16 and 22, it is inherent that the multilayer composite distorts more than 1.0% in either the machine or cross machine direction when in an unrestrained state and exposed to temperatures above about 140°F and when subjected to tension greater than about 0.5 PLI, has a low flexural stiffness, has elongation characteristics as measured in accordance with ASTM D 8-22 greater than 50% in at least one direction, has elongation characteristics greater than 100% in at least one direction, has a stiffness greater than about 60 grams, the bond strength at said interface is less than the respective tensile strengths of said face stock and said carrier sheet and the yield strength of the said face stock, the bond strength as measured in accordance with FTM3 is less than 60, 100 or 200 grams per 2 inch width and the stiffness and tensile strength of the carrier sheet prevents distortion since Dollinger discloses the same material as claimed (Figure 4, #14; Column 4, lines 59 – 61; Column 5, lines 14 – 15) and overlapping properties (Columns 10 and 11, Table I). A liner is releasably adhered by means of a pressure sensitive adhesive to the bottom surface of the face stock material (Column 9, lines 39 – 44; Figure 4, #24) as in claim 17. The carrier sheet is an extrusion coated film of polystyrene or polypropylene (Column 4, lines 59 – 65; Column 5, lines 14 – 16) as in claims 20 and 21.

Response to Arguments

10. Applicant's arguments with respect to claims 1 – 11 and 13 – 21 have been considered but are moot in view of the new ground(s) of rejection. However, since the same prior art is being applied in the above rejections, the arguments will be responded to below.

Applicants assert that the examiner has not provided extrinsic evidence to prove that the claimed properties are inherent to multilayer composite comprising a face stock of the references. The examiner's understanding of inherency is derived from MPEP 2112. This section states:

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

In the present case, the technical reasoning flows from the fact that “Products of identical compositions cannot have mutually exclusive properties.” MPEP 2112.01. In re Spada, 15 PQ2d 1655, 1658 (CCPA 1990). In other words, the compositions of the references fall squarely within the presently claimed compositional structure and therefore these compositions must have the same properties as those claimed.

The examiner further notes that:

“[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency' under 35 U.S.C. 102, on prima facie obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted].” The burden of proof is similar to that required with respect to product-by-process claims. In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).

Applicants further assert that the “certain thing” (in this case the properties) does not flow naturally from the references. The examiner disagrees. The ‘certain thing’ flows from the reference because, again, identical compositions must have the same properties. MPEP 2112

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 10:00-7:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer
Examiner
Art Unit 1772

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Nasser Ahmad 8/28/06
NASSER AHMAD
PRIMARY EXAMINER